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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/142,471	11/04/1998	STEFAN ROSE-JOHN	012627-009	2240

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EXAMINER

O HARA, EILEEN B

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 09/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/142,471

Applicant(s)

ROSE-JOHN, STEFAN

Examiner

Eileen O'Hara

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-9,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 July 2005 and 08 September 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-5, 7-9, 13 and 14 are pending in the instant application. Claims 1 and 14 have been amended as requested by Applicant in the Paper filed July 8, 2005.

### ***Withdrawn Objections and Rejections***

2. Any objection or rejection of record which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

### ***Formal Matters***

3. The submission of drawings for Figures 1-3 that include the sequence identifiers is acknowledged.

### ***Sequence Compliance***

4. The CRF and paper copy of the sequence listing submitted July 8, 2005 were found to have errors, and were not entered. The errors are explained on the attached raw sequence listing error report.

Applicant is given the statutory time from the mailing date of this communication within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). Direct the reply to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the reply.

Applicant needs to provide a substitute computer readable form (CRF) copy of a "Sequence Listing" which includes all of the sequences recited in the claims and specification of the instant application which are encompassed by these rules, a substitute paper copy of that "Sequence Listing", an amendment directing the entry of that paper copy into the specification, and a statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. §§ 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). For rules interpretation Applicant may call (571) 272-2510. See M.P.E.P. 2422.04. For CRF submission help, call (571) 272-2501/2583.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated or cultured transformant comprising an expression plasmid, does not reasonably provide enablement for a transformant comprising an expression plasmid. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The claim is directed to a broad genus of host cells comprising an expression plasmid which, in turn, comprises the claimed DNA. The specification contemplates three subgenera in which such host cells can be made and used. On page 4, lines 22-25, it is stated "while for the expression in animal cells, which may be present within an organism or outside thereof". Therefore, the specification encompasses making and using the host cells in culture, in gene therapy, and in multicellular, transgenic organisms.

Case law directs that the presence of inoperative embodiments within the scope of a claim does not necessarily render a claim non-enabled. The standard is whether a skilled person could determine which embodiments that were conceived, but not yet made, would be inoperative or operative with expenditure of no more than is normally required in the art. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1577, 224 USPQ 409, 414 (Fed. Cir. 1984) (prophetic examples do not make the disclosure nonenabling). However, claims reading on significant numbers of inoperative embodiments would render claims non-enabled

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when the specification does not clearly identify the operative embodiments and undue experimentation is involved in determining those that are operative. *Ibid.*; *In re Cook*, 439 F.2d 730, 735, 169 USPQ 298, 302 (CCPA 1971). Since the instant specification asserts that the claimed host cells can be made and used in three contexts, two of which are not enabled for the reasons set forth below, the instant fact pattern corresponds to the second situation wherein the claims encompass a significant number of inoperative embodiments and thus should be rejected under 35 U.S.C. § 112, first paragraph, as not being enabled for the full scope of the claims.

The specification asserts that host cells can be made and used in three contexts. 1) The specification contemplates making and using isolated host cells in culture to produce the encoded protein recombinantly. Such is enabled, since the specification and prior art provide specific guidance on how to make and use host cells for this purpose. Undue experimentation would not have been required of the skilled artisan to make and use the claimed host cells in this context.

2) The specification also encompasses that the claimed gene products can be expressed in transgenic animals. However, there are no methods or working examples disclosed in the instant application whereby a multicellular animal with the incorporated claimed gene is demonstrated to express the encoded peptide. There are also no methods or working examples in the specification indicating that a multicellular animal has the claimed gene "knocked out". The unpredictability of the art is *very high* with regards to making transgenic animals. For example, Wang et al. (Nuc. Acids Res. 27: 4609-4618, 1999; pg 4617) surveyed gene expression in transgenic animals and found in each experimental animal with a single "knock-in" gene, multiple changes in genes and protein products, often many of which were unrelated to the original gene. Likewise, Kaufman et al (Blood 94: 3178-3184, 1999) found transgene expression

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levels in their transfected animals varied from "full" (9 %) to "intermediate" to "none" due to factors such as "vector poisoning" and spontaneous structural rearrangements (pg 3180, col 1, 2<sup>nd</sup> full paragraph; pg 3182-3183). Additionally, for example, the specification discloses that two possible techniques used to introduce the claimed transgene into animals include pronuclear microinjection and gene targeting in embryonic stem cells. However, the literature teaches that the production of transgenic animals by microinjection of embryos suffers from a number of limitations, such as the extremely low frequency of integration events and the random integration of the transgene into the genome which may disrupt or interfere with critical endogenous gene expression (Wigley et al. *Reprod Fert Dev* 6: 585-588, 1994). The inclusion of sequences that allow for homologous recombination between the transgenic vector and the host cell's genome does not overcome these problems, as homologous recombination events are even more rare than random events. Therefore, in view of the extremely low frequency of both targeted and non-targeted homologous recombination events in microinjected embryos, it would have required undue experimentation for the skilled artisan to have made any and all transgenic non-human animals according to the instant invention. Furthermore, regarding gene targeting in embryonic stem cells, the specification does not provide guidance for identifying and isolating embryonic stem cells or for identifying other embryonal cells which are capable of contributing to the germline of any animal. At the time of filing, Campbell et al. teaches that, "in species other than the mouse the isolation of ES cells has proved more difficult. There are reports of ES-like cell lines in a number of species...However, as yet there are not reports of any cell lines which contribute to the germ line in any species other than mouse" (Campbell et al. *Theriology* 47(1): 63-72, 1997; see pg 65, 2<sup>nd</sup> paragraph). Thus, based on the art recognized unpredictability of

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isolating and using embryonic stem cells or other embryonal cells from animals other than mice to produce transgenic animals, and in view of the lack of guidance provided by the specification for identifying and isolating embryonal cells which can contribute to the germ line of any non-human mammal other than the mouse, such as dogs or cows, the skilled artisan would not have had a reasonable expectation of success in generating any and all non-human transgenic animals using ES cell technology.

3) The specification also encompasses genetically engineering host cells to express such products *in vivo*, and encompasses gene therapy. However, the specification does not teach any methods or working examples that indicate the claimed nucleic acid is introduced and expressed in a cell for therapeutic purposes. The disclosure in the specification is merely an invitation to the artisan to use the current invention as a starting point for further experimentation. For example, the specification does not teach what type of vector would introduce the claimed nucleic acid into the cell or in what quantity and duration. Relevant literature teaches that since 1990, about 3500 patients have been treated via gene therapy and although some evidence of gene transfer has been seen, it has generally been inadequate for a meaningful clinical response (Phillips, A., J Pharm Pharmacology 53: 1169-1174, 2001; abstract). Additionally, the major challenge to gene therapy is to deliver DNA to the target tissues and to transport it to the cell nucleus to enable the required protein to be expressed (Phillips, A.; pg 1170, ¶ 1). Phillips also states that the problem with gene therapy is two-fold: 1) a system must be designed to deliver DNA to a specific target and to prevent degradation within the body, and 2) an expression system must be built into the DNA construct to allow the target cell to express the protein at therapeutic levels for the desired length of time (pg 1170, ¶ 1). Therefore, undue experimentation would be

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required of the skilled artisan to introduce and express the claimed nucleic acid into the cell of an organism to treat disease. Additionally, gene therapy is unpredictable and complex wherein one skilled in the art may not necessarily be able to introduce and express the claimed nucleic acid in the cell of an organism or be able to produce the encoded protein in that cell.

Due to the large quantity of experimentation necessary to generate a transgenic animal expressing the disclosed protein and to introduce and express the claimed nucleic acid in a cell of an organism for therapy, the lack of direction/guidance presented in the specification regarding how to introduce the claimed nucleic acid in the cell of an organism to be able produce the encoded protein, the absence of working examples directed to same, the complex nature of the invention, the state of the prior art which establishes the unpredictability of making transgenic animals and the unpredictability of transferring genes into an organism's cells, and the breadth of the claims which fail to recite any cell type limitations, undue experimentation would be required of the skilled artisan to make and/or use the claimed invention in its full scope.

Please note that this rejection could be overcome by amending the claim to recite, for example, "An isolated transformant ..." because such an amendment would clarify that the claims are directed only to host cells which are to be made and used in culture as described in context 1) above.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



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6. Claims 1-5, 7-9, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6.1 Claims 1-5, 7-9, 13 and 14 are indefinite because they depend from claim 1. Claim 1 is drawn to a fusion polypeptide comprising a first and second polypeptide, the polypeptides having an affinity with respect to each other, wherein the first polypeptide is an interleukin-6, interleukin-11, CNTF or subunit thereof, and the second polypeptide is a receptor or subunit thereof. In the specification on page 2, states:

“The expression “polypeptides with a mutual affinity” relates to polypeptides of any kind, origin and length, which have an affinity for each other.”

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation “the polypeptides having an affinity with respect to each other”, and the claim also recites “wherein

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the first polypeptide is an interleukin-6, interleukin-11, CNTF or subunit thereof, and the second polypeptide is a receptor or subunit thereof", which is the narrower statement of the range/limitation.

Additionally, it is not clear if the "or the subunit thereof" on line 4 relates just to CNTF or to interleukin-6, interleukin-11 or CNTF.

It is recommended that claim 1 be amended as follows:

- 1. A fusion polypeptide comprising a first and second polypeptide, wherein the first polypeptide is a cytokine selected from the group consisting of interleukin-6, interleukin-11 or CNTF, or wherein the first polypeptide is a subunit of interleukin-6, interleukin-11 or CNTF, wherein said subunit can bind an interleukin-6, interleukin-11 or CNTF receptor, and the second polypeptide is an interleukin-6, interleukin-11 or CNTF receptor, or subunit thereof of the receptors, and wherein the receptor subunits can bind their respective cytokines, wherein the first and second polypeptides are linked to each other via a polypeptide linker. -

6.2 Claim 2 is also indefinite because it recites "wherein the receptor is a subunit of *a* cytokine receptor and binds to *a* ligand" and the article "a" before "cytokine receptor" and "ligand" makes it unclear what receptor is being claimed or what ligand the receptor subunit would bind, if they are not limited to those recited in claim 1. Claim 2 is also indefinite because it recites "the receptor is a subunit of a cytokine receptor", and it is not clear how the receptor can be itself and a subunit. It is suggested that claim 2 be rewritten as follows:

- 2. The fusion polypeptide according to claim 1, wherein the second polypeptide is a subunit of the cytokine receptor and binds to said cytokine. -

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6.3 Claim 3 is also indefinite because it recites "the cytokine is a subunit of a cytokine", and it is not clear how the cytokine can be itself and a subunit. It is suggested that "the cytokine" be substituted with "the first polypeptide". Claim 3 is also indefinite because it recites "wherein the cytokine is a subunit of *a* cytokine" and the article "a" before "cytokine" makes it unclear what cytokine is being claimed, if it is not limited to the three recited in claim 1.

- 3. The fusion polypeptide according to claim 1, wherein the first polypeptide is a subunit of the cytokine and binds to said receptor. -

### ***Conclusion***

7. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached at (571) 272-0829.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

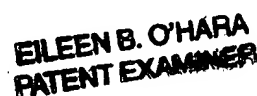
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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Eileen B. O'Hara, Ph.D.

Patent Examiner

A handwritten signature in cursive script that reads "Eileen B. O'Hara".An official rectangular stamp with the text "EILEEN B. O'HARA" on the top line and "PATENT EXAMINER" on the bottom line, both in all caps.

<b>Notice to Comply</b>	<b>Application No.</b> 09/142,471	<b>Applicant(s)</b> Rose-John	
	<b>Examiner</b> Eileen B. O'Hara	<b>Art Unit</b> 1646	

**NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES**

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☐ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☐ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: errors found in sequence listing

**Applicant Must Provide:**

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (571)272-2510

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